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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/923,716	08/07/2001	Joachim Kramer	AP33451(070180.0144)	1120

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EXAMINER
COUNTS, GARY W

ART UNIT	PAPER NUMBER
1641	

DATE MAILED: 08/26/2003

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Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	09/923,716	KRAMER ET AL.	
	Examiner	Art Unit	
	Gary W. Counts	1641	

-- The MAILING DATE of this communication appears on the cover she t with th correspond nc address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *Augsut 5, 2003* .

2a)☐ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-15,17-26 and 29-35* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☐ Claim(s) _____ is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☒ Claim(s) *1-15,17-26 and 29-35* are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

11)☐ The proposed drawing correction filed on _____ is: a)☐ approved b)☐ disapproved by the Examiner.

If approved, corrected drawings are required in reply to this Office action.

12)☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

13)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____ .

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

14)☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).

a) ☐ The translation of the foreign language provisional application has been received.

15)☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ .
4) ☐ Interview Summary (PTO-413) Paper No(s). _____ .
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: .

DETAILED ACTION

Election/Restrictions

1. Restriction to one of the following inventions is required under 35 U.S.C. 121:

I. Claims 1-11, 17, 23-26, 31-33 and 12 drawn to a process for detecting threonine or serine kinase activity, classified in class 435, subclass 7.92.

II. Claims 1-11, 17, 23-26, 31-33, 13 and 14 drawn to a process for detecting threonine or serine kinase activity, classified in class 435, subclass 7.92.

III. Claims 1-11, 17, 23-26, 31-33 and 15 drawn to a process for detecting threonine or serine kinase activity, classified in class 435, subclass 7.92.

IV. Claims 1-11, 17, 23-26, 31-33 and 22 drawn to a process for detecting threonine or serine kinase activity, classified in class 435, subclass 7.92.

V. Claims 29 and 30, drawn to an immunoassay for screening modulators of threonine or serine kinase activity, classified in class 435, subclass 7.1.

Invention I-IV are independent and distinct inventions. Invention I requires that the sequence motif comprises proline or glutamate or glycine or combinations thereof. Invention II requires the threonine or serine kinase substrate protein or peptide is the active site loop of JNK1, the active site loop of JNK2 and the active site loop of JNK3. Invention III requires the substrate protein or substrate peptide comprises the amino acid sequence of SEQ ID NO 2. Invention IV requires that the antibody is a polyclonal antibody specific for bis-phosphorylated active site. Each of these proteins are

functionally and structurally different and thus require a divergent search and therefore imposes a burden upon the Examiner.

Inventions I-IV and V are independent and distinct inventions. The inventions of I-IV are directed to a process for detecting threonine or serine kinase activity in an immunoassay whereas invention V is an immunoassay for screening modulators of threonine or serine kinase activity. Futhermore, invention V requires the addition of a test compound and comparing the threonine or serine kinase activity in the presence of the test compound with the threonine or serine kinase activity in the absence of the test compound and inventions I-IV do not require these limitations.

Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification, and the search required for one group is not required for other restriction for examination purposes as indicated is proper.

2. Claims 1-11 and 17 link(s) inventions 12, 13, 14, 15 and 22. The restriction requirement among the linked inventions is subject to the nonallowance of the linking claim(s), claims 1-11 and 17. Upon the allowance of the linking claim(s), the restriction requirement as to the linked inventions shall be withdrawn and any claim(s) depending from or otherwise including all the limitations of the allowable linking claim(s) will be entitled to examination in the instant application. Applicant(s) are advised that if any such claim(s) depending from or including all the limitations of the allowable linking claim(s) is/are presented in a continuation or divisional application, the claims of the continuation or divisional application may be subject to provisional statutory and/or

nonstatutory double patenting rejections over the claims of the instant application. Where a restriction requirement is withdrawn, the provisions of 35 U.S.C. 121 are no longer applicable. *In re Ziegler*, 44 F.2d 1211, 1215, 170 USPQ 129, 131-32 (CCPA 1971). See also MPEP § 804.01.

3. Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Gary W. Counts whose telephone number is (703) 305-1444. The examiner can normally be reached on M-F 8:00 - 4:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Long Le can be reached on (703) 305-3399. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0196.

Gary W. Counts
Examiner
Art Unit 1641
August 21, 2003

LONG V. LE
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 1600
08/22/03